



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,249	02/27/2002	Joseph Giordano	24124.000172	8236
7590 09/10/2007 Thomas J. Scott Intellectual Property Department Hunton & Williams 1900 K Street, N.W., Suite 1200 Washington, DC 20006-1109			EXAMINER GRAHAM, CLEMENT B	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/083,249

**Applicant(s)**

GIORDANO ET AL.

**Examiner**

Clement B. Graham

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11,13-26,50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,13-26,50 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### DETAILED ACTION

1. In view of the Appeal Brief filed on 05/14/07 PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 11, and 13-26, 50-51, remained pending.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11, 13-26 and 50-51, are rejected under 35 U.S.C. 103(a) as being unpatentable over by Kaehler et al (Hereinafter Kaehler 6, 089, 284).

As per claim 11, Kaehler discloses method for processing transactions and merchant award program data the method comprising:  
transmitting a first signal from a merchant transceiver to a customer transceiver("transponder") wherein said first signal causes generation of operative power ("passive or active" see column 7 lines 5-10") that enables the customer transceiver to transmit a second signal to the merchant transceiver;  
communicating the second signal to point-of-sale device, said second signal comprising customer identification data(see column 2 lines 6-65)

Art Unit: 3692

transmitting an authorization request from said point of-sale device("fuel dispenser") to a host transaction processing method, said authorization request comprising said customer identification data(see column 12 lines 28-65 and column 9 lines 1-63 and column 31 lines 60-67 and column 32 lines 1-6) a merchant identifier and transaction data; determining, from said customer identification data, loyalty award program data that corresponds to said customer identification data, said merchant identifier, or a combination thereof; transmitting, from said host transaction processing method to said point-of-sale device said loyalty award program data and a response to said authorization request.(see column 14 lines 53-67 and column 15-17 lines 1-67). Kaehler fail to explicitly teach wherein the loyalty award program data comprises a loyalty award amount that is redeemable with a merchant other than a merchant associated with the merchant identifier.

However Kaehler discloses the present invention may also be configured to provide various types of loyalty benefits based on past and/or current transactions. Loyalty benefits will be provided to a customer in order to encourage subsequent return to a particular fueling environment or one of an associated group of environments. The benefit may also encourage the purchase of additional products during the current or a subsequent transaction. The benefits may include cash rebates or discounts providing a type of electronic couponing to enhance merchandising and marketing efforts. A loyalty point may be earned by a customer for each transaction, transaction amount, or type or quantity of a particular product or service. For example, a loyalty point may be earned for each gallon of gas purchased or for a fill-up requiring eight or more gallons of gas. The store operators have tremendous flexibility in determining the various criteria for earning loyalty points. Additionally, the loyalty benefits or points are preferably redeemed by a customer in part, or in whole, on subsequent visits to the same or an associated fueling environment. Redeeming points at a subsequent transaction provides an incentive for a customer to return to environments participating in the benefit program. Although redeeming points on a subsequent purchase is preferred, benefits may be made immediately available based solely on the current transaction. Furthermore, the benefits may be based upon current and prior transactions, and allow

Art Unit: 3692

for both current and subsequent benefit. The basic flow of the process for providing such benefits is shown in FIG. 10C. (see column 14 lines 53-67 and column 15 lines 1-28).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the redeemable loyalty award program and features of Kaehler when applied could have perform the functions of the loyalty award program data comprises a loyalty award amount that is redeemable with a merchant other than a merchant associated with the merchant identifier.

As per claim 13, Kaehler discloses wherein said secondary authorization data is used to process transactions and redeem loyalty award program data. (see column 14 lines 53-67 and column 15-17 lines 1-67).

As per claim 14, Kaehler discloses wherein said secondary authorization data comprises a personal identification number manually entered at said point-of-sale.(see column 7 lines 1-65).

As per claim 15, Kaehler discloses wherein said secondary authorization data comprises biometric data.(see column 2 lines 60-65).

As per claim 16, Kaehler discloses wherein said loyalty award program data is used as payment for a transaction that corresponds to said transaction data. (see column 14 lines 53-67 and column 15-17 lines 1-67).

As per claim 17, Kaehler discloses wherein said loyalty award program data authorizes a user associated with the customer identification data to a discount on a product or service from a merchant. (see column 14 lines 53-67 and column 15-17 lines 1-67).

As per claim 18, Kaehler discloses wherein said product or service corresponds to said transaction data. (see column 14 lines 53-67 and column 15-17 lines 1-67).

As per claim 19, Kaehler discloses wherein said loyalty award program data authorizes a user associated with the customer identification data to a free product or service from a merchant. (see column 14 lines 53-67 and column 15-17 lines 1-67).

As per claim 20, Kaehler discloses wherein said product or service corresponds to said transaction data. (see column 14 lines 53-67 and column 15-17 lines 1-67).

Art Unit: 3692

As per claim 21, Kaehler discloses a method for enrolling users in a transaction processing program ("i. e, pre registration" see column 38 lines 40-65) comprising: transmitting transmitter identification data from a customer transponder to a point-of-sale device(see column 2 lines 49-65) transmitting payment information to said point-of-sale device(see column 11 lines 1-14 and column 3-29) associating said transmitter identification data with said payment information(see column 11 lines 1-14 and column 3-29) transmitting said associated transmitter identification data and said payment information to a host transaction processing system(see column 11 lines 1-14 and column 3-29) and enrolling a user associated with the customer transponder by storing enrollment data comprising said associated transmitter identification data and said payment information in said host transaction processing system. (see column 19 lines 30-43) and column 3-29 and column 38 lines 40-65).

Kaehler fail to explicitly teach enrolling a user associated with the customer transponder by storing enrollment data comprising said associated transmitter identification data and said payment information in the said host transaction processing system.

However Kaehler discloses the manner in which pre-registration for credit cards may be accomplished could be by an application that is sent to the credit card or fuel card companies indicating the choice of information to be delivered. For example, the information choices could include weather reports, local traffic reports, stock reports, etc.(see column 38 lines 50-67 and column 39 lines 1-5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to that the teachings of Kaehler pre-registration and registration process would have been able to perform the functions of storing identification and payment data or information in the host system.

As per claim 22, Kaehler discloses wherein said payment information corresponds to a credit card, debit card, or bank account, or a combination thereof.(see column 7 lines 30-43).

As per claim 23, Kaehler discloses further comprising transmitting additional customer information to said host transaction processing method, associating said



Art Unit: 3692

additional customer information with said transmitter identification data and said payment information, and storing said associated additional customer information, transmitter identification data and said payment information. (see column 2 lines 50-65 and column 19 lines 30-43 and column 3-29).

As per claim 24, Kaehler discloses a method for enrolling users in a transaction processing program ("i. e, pre registration" see column 38 lines 40-65) comprising: transmitting transmitter identification data from a customer transponder to one of a plurality of point-of-sale devices; transmitting payment information to said one of a plurality of point-of-sale devices; transmitting said transmitter identification data and said payment information to a host transaction processing method(see column 2 lines 50-65 and column see column 14 lines 37-40 and column 19 lines 3-29) assigning a unique customer identifier that corresponds to said transmitter identification data (see column 2 lines 6-65) associating said unique customer identifier, said transmitter identification data(see column 2 lines 50-65) and said payment information(see column 19 lines 3-29) and storing said associated unique customer identifier, transmitter identification data and payment information in said host transaction processing system (see column 2 lines 50-65 and column 19 lines 30-43 and column 3-29 and column 38 lines 40-65).

Kaehler fail to explicitly teach and enrolling a user associated with the customer transponder by storing enrollment data comprising said associated transmitter identification data and said payment information in said host transaction processing system.

However Kaehler discloses the manner in which pre-registration for credit cards may be accomplished could be by an application that is sent to the credit card or fuel card companies indicating the choice of information to be delivered. For example, the information choices could include weather reports, local traffic reports, stock reports, etc.(see column 38 lines 50-67 and column 39 lines 1-5).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to that the teachings of Kaehler pre-registration and registration

Art Unit: 3692

process would have been able to perform the functions of storing identification and payment data or information in the host system.

As per claim 25, Kaehler discloses wherein said payment information corresponds to a credit card, debit card, or bank account, or a combination thereof.(see column 7 lines 30-43).

As per claim 26, Kaehler discloses further comprising transmitting additional customer information to said host transaction processing method, associating said additional customer information with said transmitter identification data and said payment information, and storing said associated additional customer information, transmitter identification data and said payment information. (see column 2 lines 50-65 and column 19 lines 30-43 and column 3-29).

As per claim 50, Kaehler discloses further comprising the step of determining loyalty award program data that corresponds to said merchant identifier. (see column 14 lines 53-67 and column 15-17 lines 1-67).

As per claim 51, Kaehler discloses further comprising the step of determining loyalty award program data that corresponds to a combination of said customer identification data and said merchant identifier. (see column 14 lines 53-67 and column 15-17 lines 1-67).

### **Conclusion**

### **RESPONSE TO ARGUMENTS**

5. Applicant's arguments filed 5/14/2007 has been fully considered but they are moot in view of new grounds of rejections.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.



Application/Control Number: 10/083,249

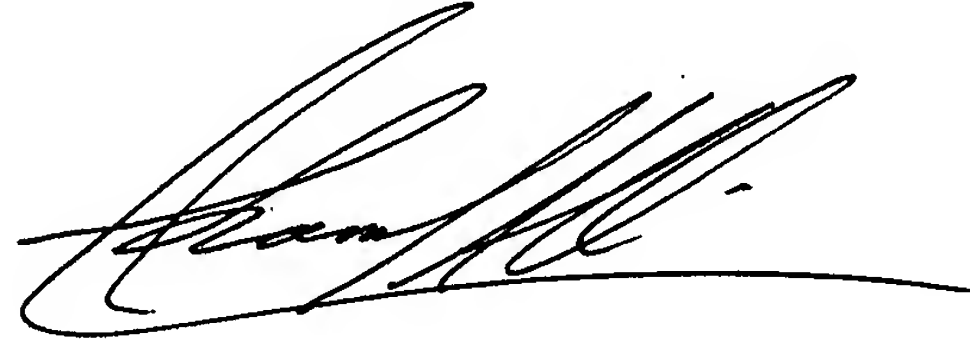
Page 8

Art Unit: 3692

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

Aug 12, 2007

A handwritten signature in black ink, appearing to be "H. M. H.", written in a cursive style.

10E 1692